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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/747,840 | 12/29/2003 | William T. Graushar | 077047-9410-02 | 6450 |

7590 10/28/2004

Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, WI 53202-4108

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| EXAMINER |
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MACKEY, PATRICK HEWEY

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| ART UNIT | PAPER NUMBER |
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3651

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/747,840

Applicant(s)

GRAUSHAR ET AL.

Examiner

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-14, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 122903.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species B, claims 1-4, 6-9, and 11-22 in the reply filed on 7/30/2004 is acknowledged. However, since claims 15-20 do not read on the elected species, the examiner has withdrawn these claims from consideration as drawn to a non-elected species. The traversal is on the ground(s) that there will not be a serious burden placed on the Examiner if the election requirement is not required. This is not found persuasive because The inventions claimed are independent. See MPEP 808.01.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 6, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. (US 5,388,815). Hill discloses a method that includes writing electronic information to an optical disk on a binding line (20), reading information from an electronic disk on a binding line (57), and associating the disk with a product printed (26) with personalized indicia.

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4. Claims 11, 13, 14, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al. (US 6,431,453). Hill discloses a method that includes reading electronic information from an optical disk on a binding line (76), and associating the optical disk with a printed product (104).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6-7, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al. in view of Hill et al. (US 5,388,815). Pace discloses a method for associating a CD with a printed product, but it does not disclose writing electronic information on a binding line. However, Hill discloses writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Pace by writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner.

7. Claims 4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al. in view of Hill et al. (US 5,388,815) as applied to claim 6 above, and further in view of Harris, Jr. et al. Pace and Hill together disclose all the limitations of the claims, but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating. However, Harris, Jr. discloses a similar method that includes printing personalized

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indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. (US 6,431,453) in view of Harris, Jr. et al. Hill discloses all the limitations of the claims, but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating. However, Harris, Jr. discloses a similar method that includes printing personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product.

Conclusion

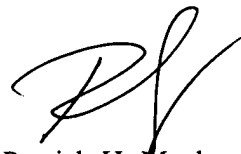
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (703) 308-0630. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick H. Mackey
Primary Examiner
Art Unit 3651

October 14, 2004